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Atty. Dkt. No: 5681-96801

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Name of Registered Representative

Signature _____

Date _____

Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

For support, the Examiner cites M.P.E.P. § 2173.05(c); *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989); *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). The Examiner's reliance on this authority is clearly misplaced. The section of the M.P.E.P. and case law cited by the Examiner only apply to situations where the language of the claims creates some doubt as to whether the narrower limitation is a required limitation or merely an example within the broader range or limitation. For example, M.P.E.P. § 2173.05(c) gives as an example of when this type of rejection is proper a claim that recites "a temperature of between 45 and 78 degrees Celsius, preferably between 50 and 60 degrees Celsius." The other example for when this type of rejection is proper mentioned in M.P.E.P. § 2173.05(c) is a claim that recites "a predetermined quantity, for example, the maximum capacity." Similarly, *Ex parte Wu*, *Ex parte Steigewald*, *Ex parte Hall* and *Ex parte Hasche* all involve situations where a claim uses terms like "optionally", "such as" or "for example" to introduce the narrower range or limitation. In contrast, the "defining ..." limitation recited in claims 1, 12, 41 and 52 is not introduced by a term like "preferably", "optionally", "such as" or "for example". The "a computer program process" and "defining ..." limitations are both recited as clear definite limitations in the claims. There is no ambiguity in how these limitations are recited in Applicants' claims. The Examiner has not cited any valid authority applicable for rejecting the present claims under 35 U.S.C. § 112, second paragraph. Applicants also point out that "breadth of a claim is not to be equated with indefiniteness." See, e.g., M.P.E.P. § 2173.04; *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

Furthermore, independent claims 33, 36 and 48 do not recite "defining ...". Since the Examiner has not addressed the actual wording of claims 33, 36 and 48, the Examiner has not stated a proper *prima facie* rejection of independent claims 33, 36 and 48.

In the Advisory Action of November 1, 2005, the Examiner states: "Claim 1 is mixing method steps with computer program steps as narrow and broad limitations. The claim fails to set forth the metes and bounds of patent protection desired." This statement

by the Examiner is not a proper reason to reject a claim as indefinite. Just because some actions recited in a method claim are performed by a computer program process and other actions recited in the method are not so limited does not make the claim indefinite. Again, Applicants point out that “breadth of a claim is not to be equated with indefiniteness.” *See, e.g.*, M.P.E.P. § 2173.04; *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). The metes and bounds of independent claims 1, 12, 33, 36, 41, 48 and 52 are easily understood by anyone of ordinary skill in the art. “If one skilled in the art would understand the bounds of the claim when read in light of the specification, then the claim satisfies section 112 paragraph 2.” *Miles Labs., Inc. v. Shandon, Inc.*, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993). “We have not insisted that claims be plain on their face in order to avoid condemnation for indefiniteness; rather, what we have asked is that the claims be amenable to construction, however difficult that task may be.” *Exxon Research & Eng’g Co. v. U.S.*, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001). “If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds.” *Id.*

Applicants assert that the meaning of the present claims is readily apparent to anyone of ordinary skill in the art. However, even if the claims are not as precise as they possibly could be, that is not a sufficient reason to rejection the claims under 35 U.S.C. § 112, second paragraph. According to MPEP § 2173.02, “some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.” “If other modes of expression selected by applicants satisfy the statutory requirements of 35 U.S.C. § 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. § 112, second paragraph.”

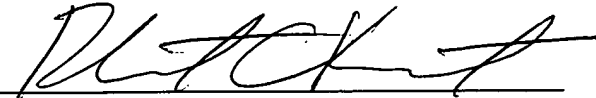
In light of the foregoing remarks, Applicant submits the application is in condition for allowance, and notice to that effect is respectfully requested. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin,

Kowert & Goetzel PC Deposit Account No. 501505/5681-96801/RCK. Also enclosed herewith are the following items:

☒ Return Receipt Postcard

☒ Notice of Appeal

Respectfully submitted,



Robert C. Kowert

Reg. No. 39,255

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Date: November 10, 2005